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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,331	01/16/2001	Hughes Roderick	D-2924	5991
33197	7590	11/26/2003	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			VO. HAI	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,331

Applicant(s)

RODERICK ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-16, 18, 19, 21-27, 29-42 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13, 15, 16, 18, 19, 21, 23-27, 29, 30, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 12, 14, 22, 31 and 36-42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1023 6) ☐ Other:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7, 8, 10, 11, 13, 16, 18, 19, 21, 23-25 are rejected under 35 U.S.C.

103(a) as being unpatentable over by Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037). Meglino teaches a fence insert comprising at least three layers wherein at least two or three of the layers are made of different polymeric materials (column 1, lines 60-63). The examiner interprets that the fence inserts comprises three layers, an inner layer, a core and an outer layer wherein at least two of three layers are made of different polymeric materials. Meglino teaches the polymeric materials being polyethylene, polypropylene (column 3, lines 1-10). The inner layer defines a hollow space extending along the entire length of the fence insert and the wall thickness of the inner layer and outer layer are shown to be constant (figure 2, column 2, line 36, and column 3, lines 30-32). The fence insert is formed by co-extrusion (column 3, lines 41-43). Meglino does not specifically teach polyethylene or polypropylene being a thermoplastic material. Godavarti, however, teaches a polyolefin wood fiber composite that comprises a combination of wood fiber with polypropylene thermoplastic material (column 6, lines 65-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ polypropylene as a thermoplastic material of the core because

such is known in the art that polypropylene is a thermoplastic material and Godavarti provides necessary details to practice the invention of Meglino.

With regard to claims 10, 11, 13, 18, Meglino does not specifically disclose the core layer including an effective amount of a wood fiber. Godavarti teaches a hollow composite structure member made of a blend of polyethylene and wood fiber in an amount of 50 to 80 parts by weight based 100 parts of the composite material (abstract, table 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the wood fibers in the core layer motivated by the desire to increase the strength of the fence insert.

With regard to claim 25, Meglino does not specifically disclose the fence insert being used as a decking plank. However, it has been held that a recitation with respect to the manner in which a claimed decking plank is intended to be employed does not differentiate the claimed decking plank from a fence insert satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

3. Claims 6, 9, 15, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) as applied to claim 1 above, further in view of Sandt (US 5,858,493). Meglino does not specifically disclose the fence insert has a substantially rectangular cross-section perpendicular to the length. Sandt teaches the pole having a rectangular cross-section perpendicular to the length (column 3, lines 46-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fence insert having the rectangular cross-section instantly claimed

because such is common shape of the fence cross-section and Sandt provides necessary details to practice the invention of Meglino.

With regard to claims 9, 15, 34, Meglino does not specifically teach the outer layer and an inner layer made of polyvinyl chloride. Sandt teaches a composite structural member having an inner layer, a core and an outer layer wherein the inner and outer layer are made of polyvinyl chloride (column 4, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the polyvinyl chloride as the out layer of Meglino because such is an intended use of the material for use in the fence poles.

4. Claims 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) and as evidenced by Robbins, III (US 4,860,996). Meglino does not teaches a fencing system having a structure as recited in the claims. Robbins, III is relied as evidence that teaches the fencing system having a plurality of fence posts and fence rails being connected to each other (figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fencing system having a structure disclosed in Robbins, III because such is common structure of the fencing system and Robbins provides necessary details to practice the invention of Meglino.
5. Claims 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) and as evidenced by Robbins, III (US 4,860,996) as applied to claim 26 above, further in view of Sandt

(US 5,858,493). Meglino does not specifically disclose the fence insert has a substantially rectangular cross-section perpendicular to the length. Sandt teaches the pole having a rectangular cross-section perpendicular to the length (column 3, lines 46-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fence insert having the rectangular cross-section instantly claimed because such is common shape of the fence cross-section and Sandt provides necessary details to practice the invention of Meglino.

Meglino does not specifically teach the outer layer and an inner layer made of polyvinyl chloride. Sandt teaches a composite structural member having an inner layer, a core and an outer layer wherein the inner and outer layer are made of polyvinyl chloride (column 4, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the polyvinyl chloride as the out layer of Meglino because such is an intended use of the material for use in the fence poles.

Allowable Subject Matter

6. Claims 12, 14, 22, 31 and 36-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The inclusion of the core layer made of a thermoplastic polymeric foam and a wood filler renders the claims patentable over the prior art. It is known in the art that the foamed thermoplastic polymer/wood fiber profile accepts and retains the insertion of

fasteners easily. There is no motivation to modify the core of the fence insert of Meglino to be a foamed thermoplastic polymer/wood fiber layer because no nails have been associated with the fence insert.

Further, the inclusion of the first polymeric material and the third polymeric material made of polyvinyl chloride and the second polymeric material is selected from the group consisting of polyvinyl chloride, acrylonitrile/styrene/acrylic and combinations thereof provides structural distinction over the prior art.

Response to Arguments

7. The declaration states that the core of Sandt is made up of a thermosetting material (paragraphs no. 7 and no. 9 of the Declaration). The declaration and the present amendment together are sufficient to overcome the art rejections in the Office Action mailed on 05/15/2003.
8. Applicant's arguments with respect to claims 1-4, 6-11, 13, 15, 16, 18, 19, 21, 23-27, 29, 30, 34, and 35 have been considered but are moot in view of the new ground(s) of rejection.
9. Applicants are reminded that the current status of all of the claims must be given in a parenthetical expression following the claim number using ***only one of the following seven status identifiers***: (original), (currently amended), (canceled), (withdrawn), (new), (previously presented) and (not entered) in accordance with revised amendment practice.


Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV


TERREL MORRIS
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